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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/033,169

12/27/2001

Dmitri Ptchelintsev

680.0048USU

5714

7590 10/20/2003

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EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 10/20/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,169

Applicant(s)

PTCHELINTSEV, DMITRI

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 11-13 and 24-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 14-23 and 28-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-33 are pending. Claims 11-13, 24-27 are withdrawn from consideration, as they are directed to non-elected subject matter.

Election/Restrictions

Applicant's election with traverse of the election/restriction requirement in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the examination of all the claims in this application is not deemed to present an undue burden on the Examiner with respect to searching. This is not found persuasive. The Examiner respectfully points out that the compound of instant formula 1 comprises an incredible number of compounds that are different in structure and function. Additionally, the instant method claims are directed to an incredible number of methods that are distinct and have distinct effects and chemical pathways. Thus, a search of all of the species in the instant claims places an undue burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

Claim 1 is objected to because of the following informalities: the term "have" should be substituted by the term "having" in lines 7, 10, 13, 15, 18, and 20 of claim 1, in order for the claim to be in proper English grammar. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The terms "poor" and "thin" in claim 15 (lines 6 and 7) are relative terms, which renders the claim indefinite. The terms "poor" and "thin" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10, 14-16, 19-20, 22-23, 28-30, 32-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Gedouin et al. (FR 2,754,447).

Gedouin et al. exemplify a composition comprising 20% mangostin (the ingredient represent by the formula of instant claim 1 and 1,3,6-trihydroxy-7-methoxy-2,8-di(3-methyl-2-butenyl)xanthone) in an emulsion (cosmetically acceptable vehicle, wherein an emulsion is a dispersion), see Table 1 on page 7. Exemplified is applying the composition to the skin for a predetermined time of 15 minutes (effective period of time), see page 10.

The claims are directed to a method of applying a composition comprising mangostin and a cosmetically acceptable vehicle to the skin. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical

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composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components as instantly claimed, which would inherently treat dermatological signs of aging (such as loss of skin tone) and/or improving the aesthetic appearance of skin, as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed. Additionally, it is respectfully pointed out that page 2 of Gedouin it is taught that applying their composition to the skin decreases the premature aging of the skin.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-18, 21, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gedouin et al. as applied to claims 1-10, 14-16, 19-20, 22-23, 29-30, 32-33 above, and further in view of Duggan et al. (2003/0092675).

The instant claims are directed toward a composition comprising the compound of instant claim 1 and a cosmetically acceptable vehicle, and methods of applying the composition to the skin.

Gedouin et al. is applied as discussed above. The reference does not teach daily application for 1-2 weeks.

Duggan et al. teach methods of improving the appearance of the skin comprising applying to the skin sunscreen compositions. The compositions are taught as being applied once or twice daily up to two or four weeks. See abstract; page 4.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the composition of Gedouin et al. as being applied daily for up to two weeks, as taught by Duggan et al., because Duggan et al. teach that daily application of skin care compositions for a time period of one to two weeks is conventional in the art and because of the expectation of achieving a product that continually protects the user from sun damage and hence, premature aging.

Conclusion

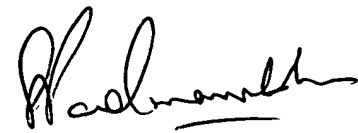
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

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SREENI PADMANABHAN
PRIMARY EXAMINER

9/4/03